

Docket No. 00-1020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ginsberg et al. Group Art Unit : 3693  
Application No. : 09/846,025 Confirmation No. : 4295  
Filed : April 30, 2001  
Title : REAL-TIME INTERACTIVE WAGERING ON EVENT  
OUTCOMES  
Examiner : Coburn, Corbett B

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

PETITION FROM REQUIREMENT FOR RESTRICTION

Sir:

This petition is being filed in response to the restriction/election requirement in the present application, which was mailed May 18, 2007 and made final in the Office Action dated July 9, 2008.

The Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-3938.

**Issue** - Is the restriction/election requirement set forth in the December 20, 2007 Office Action proper?

In the Office Action dated December 20, 2007, the Examiner required that Applicants elect from one of four groups of claims (Groups I-IV). *See* page 2, item 1. The Examiner further required that Applicants elect from one of five patentably distinct species (species a-e) from the Group I set of claims. *See id.* page 4, item 8. Applicants note that each of the species identified by the Examiner had no more than 2 claims therein. There is only one independent claim pending (claim 11). All of the alleged species are claimed in dependent claims (claims 56-60, and 61-65). In our April 17, 2008 Reply, we elected Group I and species c (claims 13, 15, and 61-62) with traverse.

For a restriction to be proper, the Examiner must show both that 1) the inventions are independent or distinct, and 2) there is a serious burden. MPEP 803(I). The Examiner must provide reasons and/or examples to support conclusions. MPEP 803(II). Applicants submit that the Examiner has not made the requisite showing for at least the following reasons:

With regard to the first prong (independent or distinct), the Examiner states that “[t]he species are independent or distinct because they are inventions usable together.” There is no law, rule, or any language in the MPEP that supports a finding of independence or distinctiveness based on “the inventions being usable together”. The Examiner has therefore not made the requisite showing to support the restriction/election requirement.

With regard to the second prong, the Examiner has not provided any explanation with regard to the burden in examining all of the claims in the elected Group. Applicants pointed this out in our April 17, 2008 Reply. In response, the Examiner states that “the Examiner determines when a burden exists.” The Examiner appears to believe that he has unlimited authority to examine only the number of claims that he subjectively believes is not burdensome, which is apparently quite low as this application was filed with 55 claims, all of which were examined by the first examiner on this application, and after two consecutive restriction requirements by the current Examiner, there are only 5

claims being examined (one independent and four dependent). The Examiner does not have unfettered authority! The Examiner “must explain why there would be a serious burden on the examiner if restriction is not required.” MPEP 808.02 (emphasis added). The MPEP provides the following circumstances that if shown with appropriate explanation can be used to make a *prima facie* showing of a serious burden: “(A) Separate classification thereof, (B) A separate status in the art when they are classified together; or C) A different field of Search.” MPEP 808.02 (emphasis added). The Examiner has not provided any explanation. Indeed, the Examiner indicated that all of the species are classified in class 463, subclass 25. See December 20, 2007 Office Action, page 2, item 1(I). The MPEP has further provided that “[w]here, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.” MPEP 808.02. As such, the Examiner has further not made and cannot make the requisite showing to support the restriction/election.

As the Examiner has failed to make the requisite showing that the restriction/election requirement set forth in the December 20, 2007 is proper, Applicants request that the Office direct the Examiner to examine claims 56-60 and 63-65 (just six more claims) that the Examiner improperly refused to examine.

Respectfully submitted,

January 9, 2008

Date

/Antonio Papageorgiou/

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